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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,785	09/13/2000	Benjamin E. Hansen	1692	7918

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TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

ESCALANTE, OVIDIO

ART UNIT PAPER NUMBER

2614

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/660,785

Applicant(s)

HANSEN ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-14 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-14 and 16-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to applicant's amendment filed on September 18, 2006. **Claims 1-4,6-14,16-25** are now pending in the present application.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1-4,6-7,10-14,16-17 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shtivelman et al. US Patent 6,078,581 in view of Norris et al. US Patent 5,805,587 and further in view of Combar et al. US patent 6,515,968.

**Regarding claim 1**, Shtivelman teaches a method of managing a telephone call from a calling station (115) to a called station (110) having a telephone service, where the called station is connected to a data network (150), (fig. 1; col. 4, lines 21-39) comprising the steps of:

forwarding the called station telephone service to an application server, (141), (col. 4, lines 48--col. 5, lines 8);

responsive to a telephone call from a calling station, forwarding the telephone call to the application server regardless of a connection status of the called station (col. 4, lines 48--col. 5, lines 8; the switch 151 forwards the call to application server switch 141);

at the application server, obtaining from an Internet Access Server (clients ISP), an IP address relating to the called station (col. 5, lines 16-30), wherein the Internet Access Server is a different server from the application server, (col. 5, lines 16-30; the server 141 retrieves the address from the ISP, thus it is a different server);

sending a screen viewable query to the called station via the data network requesting disposition of said telephone call, wherein the query includes a list of call disposition options for said telephone call, (col. 5, lines 50-col. 6, lines 13), receiving a decision on the disposition of said telephone call from the called stations, (col. 5, lines 50-col. 6, lines 13);

performing an action according to the decision, (col. 5, lines 50-col. 6, lines 13).

Shtivelman does not specifically teach wherein one of said list of call disposition options includes sending said telephone call to a voicemail system and performing an action according to

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the decision, wherein said action includes sending said telephone call to a voicemail system.

Shtivelman, however contemplates that any alternate telephone number can be used to route the incoming call, (col. 6, lines 7-14).

Nonetheless, Norris teaches of an Internet call waiting system in which a screen viewable selection menu will pop-up on a computer screen in response to an incoming call and wherein and wherein one of said list of call disposition options includes sending said telephone call to a voicemail system, (col. 8, lines 6-19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shtivelman by including an option to go to voicemail so that the called party can remain undisturbed on the Internet while still allowing the incoming caller to leave a message for the called party.

Shtivelman and Norris do not specifically teaches logging information related to the telephone call and the decision on the disposition of the telephone call, wherein the information is viewable via the data network.

In the same field of endeavor, Combar teach of a method for providing a subscriber with Internet call management disposition options and logging information related to the telephone call and the decision on the disposition of the telephone call, wherein the information is viewable via the data network, (col. 3, line 64-col. 4, line 19; col. 20, lines 26-52; col. 25, line 58-col. 26, line 3; col. 40, line 24-col. 41, line 38-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shtivelman and Norris by logging information related to the disposition of the call and allowing the user to view the information as taught by Combar so that

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the user can be able to see real-time disposition information about calls that were made to their number.

**Regarding claim 2**, Shtivelman, as applied to claim 1, teaches wherein said screen viewable query includes an option of answering said telephone call over the data network, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 3**, Shtivelman, as applied to claim 3, teaches wherein said screen viewable query includes an option of answering said telephone call using a public switched network, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 4**, Shtivelman, as applied to claim 1, teaches wherein said screen viewable query includes an option of ignoring said telephone call, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 6**, Shtivelman, as applied to claim 1, teaches wherein said screen viewable query includes an option of forwarding said telephone call to a different telephone number, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 7**, Shtivelman, as applied to claim 1, teaches wherein said screen viewable query includes an option of playing an announcement to the calling station, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 10**, Shtivelman, as applied to claim 1, teaches wherein said screen viewable query includes an option of hanging up said telephone call, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 11**, Shtivelman teaches a method of managing a telephone call from a calling station (115) to a called station (110) having a telephone service, where the called station is capable of connection to the Internet (150), (fig. 1; col. 4, lines 21-39) comprising the steps of:

forwarding the called station telephone service to an intermediate server upon said called station launching an Internet connection, (col. 4, lines 48--col. 5, lines 8);

responsive to a telephone call from a calling station, forwarding the telephone call to the intermediate server regardless of a connection status of the called station, (col. 4, lines 48--col. 5, lines 8);

responsive to a telephone call from a calling station received by said intermediate server, obtaining from an Internet Access Server, an IP address relating to the called station (col. 4, lines 48--col. 5, lines 8; the switch 151 forwards the call to application server switch 141), wherein the Internet Access Server is a different server from the intermediate server, (col. 5, lines 16-30; the server 141 retrieves the address from the ISP, thus it is a different server);

sending a screen viewable communication to the called station including available calling station identification information and a query to the called station via the Internet requesting a decision from a list of call disposition options for said telephone call, receiving a decision from the called station choosing at least one call disposition option, (col. 5, lines 50--col. 6, lines 13); and performing an action according to the call disposition option, (col. 5, lines 50--col. 6, lines 13).

Shtivelman does not specifically teach wherein one of said list of call disposition options includes sending said telephone call to a voicemail system. Shtivelman, however contemplates that any alternate telephone number can be used to route the incoming call, (col. 6, lines 7-14).

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Nonetheless, Norris teaches of an Internet call waiting system in which a screen viewable selection menu will pop-up on a computer screen in response to an incoming call and wherein and wherein one of said list of call disposition options includes sending said telephone call to a voicemail system, (col. 8, lines 6-19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shtivelman by including an option to go to voicemail so that the called party can remain undisturbed on the Internet while still allowing the incoming caller to leave a message for the called party.

Shtivelman and Norris does not specifically teaches logging information related to the telephone call and the decision choosing at least one call disposition option, wherein the information is viewable via the data network.

In the same field of endeavor, Combar teaches of a method for providing a subscriber with Internet call management disposition options and logging information related to the telephone call and the at least one call disposition option, wherein the information is viewable via the data network, (col. 3, line 64-col. 4, line 19; col. 20, lines 26-52; col. 25, line 58-col. 26, line 3; col. 40, line 24-col. 41, line 38-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shtivelman and Norris by logging information related to the disposition of the call and allowing the user to view the information as taught by Combar so that the user can be able to see real-time disposition information about calls that were made to their number.



**Regarding claim 12**, Shtivelman, as applied to claim 11, wherein one of said list of call disposition options includes answering said telephone call over the Internet and said step of performing an action includes answering said telephone call over the Internet, (col. 5, lines 50-56).

**Regarding claim 13**, Shtivelman, as applied to claim 11, teaches wherein one of said list of call disposition options includes answering said telephone call using a public switched network and said step of performing an action includes answering said telephone call using a public switched network, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 14**, Shtivelman, as applied to claim 11, teaches wherein one of said list of call dispositions options includes ignoring said telephone call, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 16**, Shtivelman, as applied to claim 11, teaches wherein said list of call disposition option includes forwarding said telephone call to a different telephone number and said step of performing an action includes forwarding said telephone call to a different telephone number, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 17**, Shtivelman, as applied to claim 11, teaches wherein said list of call disposition options includes placing the calling station on hold and said step of performing an action includes playing an announcement to the calling station, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 20**, Shtivelman, as applied to claim 11, teaches wherein said list of call disposition options includes hanging up said telephone call and said step of performing an action includes hanging up said telephone call, (col. 5, lines 50-col. 6, lines 13).

**Regarding claim 21**, Shtivelman, as applied to claim 11, teaches wherein said list of call disposition options includes adding the available calling station identification information to a database and said step of performing an action includes adding the available calling station identification information to a database, (col. 5, lines 41-col. 6, lines 13).

**Regarding claim 22**, Shtivelman, as applied to claim 11, teaches wherein said list of call disposition options includes displaying information stored about the calling station and said step of performing an action includes displaying information stored about the calling station, (col. 5, lines 41-col. 6, lines 13).

6. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shtivelman in view of Norris and further view of Combar and further in view of Adams US Patent Pub. 2004/0240651.

**Regarding claims 8 and 18**, Shtivelman and Norris do not specifically teach wherein said screen viewable query includes an option of forwarding said telephone call to a different number, playing an announcement to the calling station and placing the call on hold.

In the same field of endeavor, Adams teaches wherein said query includes an option of forwarding said telephone call to a different telephone number, (paragraph 0055); wherein said screen viewable query includes an option of playing an announcement to the calling station, (paragraphs 0055 and 0057); and wherein said screen viewable query includes an option of placing the calling station on hold, (paragraphs 0057 and 0091).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shtivelman, Norris and Combar by adding the options of placing

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the calling station on hold as taught by Adams so that the called party can be provided with more options to send the calling party if the called party is currently on the line with another caller.

7. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shtivelman in view of Norris and further in view of Combar et al. US patent 6,515,968 and further in view of Norris US Patent 6,653,611, (hereinafter Norris '611).

*Regarding claims 9 and 19*, Shtivelman in view of Norris do not specifically teach of adding the calling station to a conference call bridge.

In the same field of endeavor, Norris '611 teaches wherein said screen viewable query includes an option of adding the calling station to a conference call bridge, (col. 8, lines 51-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shtivelman in view of Norris and Combar to add the feature of connecting via the data network and adding an option of conferencing as taught by Norris '611 so that the user can talk with the incoming caller without losing their Internet connection and so that the user can connect with a third party if they are already on the line with a first party.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims **1-4,6-14,16-25** have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7537, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-F from 6:30AM to 3:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE**  
**PATENT EXAMINER**

*Ovidio Escalante*

Ovidio Escalante  
Primary Patent Examiner  
Group 2614  
November 16, 2006

O.E./oe